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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
2,276	01/10/79	Frans Janssens, et al	JAB-286

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EXAMINER	
Bond	
ART UNIT	PAPER NUMBER
121	MAILED 3

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

SEP 6 1979

GROUP 120

☒ This application has been examined. ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THIRTY months from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited, Form PTO-892. 2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152. 4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-16 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-16 are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

Because of the lengthy specification in this application, it has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is therefore requested in promptly correcting any errors of which he may become aware in the specification.

In re Weber et al, 198 USPQ 328, has been remanded to the Board of Appeals for consideration of an improper Markush rejection based on case law.

If the members of a Markush-type group are so diverse that they will support separate patents, i.e., a reference for one would not constitute a reference for the others, then restriction is considered to be a proper procedure.

A rejection of Markush-type claims as being improper, based on case law is still very much with us, as noted by Judge Rich in Weber, above, at 198 USPQ 334, second column.

In Weber, above, at 198 332, In re Hengehold, 169 USPQ 473 was noted for the proposition that as long as applicant has retained the right (as he does here) to claim the non-elected subject matter in divisional applications, restriction is proper where independent and distinct inventions are being claimed in the same application.

Claims 1, 6, 11 and 16 are improper Markush-type claims. Ex parte Markush, 1925 C.D. 126, provided for this special kind of claim structure where there was an emergency engendered need, as where the substances were "so closely related that they would not support a series of patents." This is not the case here. Therefore the instant generic claims constitute a misjoinder of invention. See, for example, Ex parte Reid, 105 USPQ 251; In re Winnek, 73 USPQ 225; In re Ruzicka 66 USPQ 226.

Claims 1, 6, 11 and 16 constitute a misjoinder of invention, 37 CFR 1.105, as they group together species inventions that are distinct and separately classified and will support separate patents.

Claims 1, 6, 11 and 16 are therefore improper Markush-type claims. Note Judge Rich's comments in Weber, above, at 198 USPQ 334. In regard to what constitutes a proper Markush claim, see, for example, the above cited case law on the subject. Also, Judge Rich noted the discretionary power to require an applicant "at least to restrict one application to one claimed invention."

Applicants are required to (I) restrict their invention to a single disclosed species even though this requirement be traversed and (II) to list all claims readable thereon, including any claims subsequently added.

Serial No. 2,276

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Art Unit 121

Applicants are given 30 days from the date of this letter to comply with the above requirements.

Applicants may present claims for the non-elected subject matter in appropriate divisional applications. Claims 1, 6, 11 and 16 should be amended to reflect the elected invention or else replaced by new claims which do so.

Applicants may, at their option, choose to prosecute method of use and pharmaceutical composition claims of a scope commensurate with the elected compounds either in the same application with the elected compounds or in a separate application.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET EXPIRE THIRTY DAYS FROM THE DATE OF THIS LETTER .

ROBERT T. BOND

Bond/tmw

A/C 703

557-2517

9/5/79

Robert T. Bond

ROBERT T. BOND
EXAMINER
ART UNIT 121